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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/816,949	04/05/2004	Michael Rooke	060091.00284	2406

32294 7590 01/16/2008
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EXAMINER

LY, NGHI H

ART UNIT PAPER NUMBER

2617

MAIL DATE DELIVERY MODE

01/16/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/816,949

Applicant(s)

ROOKE ET AL.

Examiner

Nghi H. Ly

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-21, 23-36, 45-47 and 49-69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-21, 23-36, 45-47 and 49-69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 2, 5, 8, 9, 11-20, 23, 26, 27, 29-36, 45, 46, 49, 52, 53, 55-60, 65 and 66 are rejected under 35 U.S.C. 102(e) as being anticipated by Sofer et al (2006/0030304A1).

Regarding claims 1, 19, 45, 60, 65 and 66, Sofer teaches an apparatus (see fig.1), the arrangement comprising: a first system entity configured to provide a multimedia messaging service to user equipment connected to a network of a system (see Abstract and fig.1, item 20 or 30), and a second system entity configured to provide a value added service (see Abstract and fig.1, item 20 or 30, and see [0004], [0014], [0018], [0029], [0030], [0037], [0039], [0041], [0042], [0054] and [0069]) to a user of the user equipment via the multimedia messaging service (see Abstract, [0004],

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[0020], [0021], [0067], [0068] and [0070]), wherein the first system entity is configured to send a message to the second system entity (see [0020], [0021], [0067], [0068] and [0070]), the message comprises roaming information about the user equipment (see [0019], [0067] and [0068]), the second system entity is configured to use the roaming information when providing the value added service to the user equipment (see Abstract, [0004], [0014], [0037], [0041], [0042] and [0069]).

Regarding claims 2, 20, 46 and 56, Sofer further teaches the roaming information comprises a roaming status configured to indicate whether the user equipment is roaming outside a home network of the user equipment (see [0004], [0014], [0018], [0029], [0030], [0037], [0039], [0041], [0042], [0054] and [0069]).

Regarding claims 5, 23 and 49, Sofer further teaches the second system entity is configured to adapt, based on the roaming information (see [0004], [0014], [0018], [0029], [0030], [0037], [0039], [0041], [0042], [0054] and [0069]).

Regarding claims 8, 26 and 52, Sofer further teaches the second system entity is configured to determine, based on the roaming information, whether the value added service is providable to the user equipment (see [0004], [0014], [0018], [0029], [0030], [0037], [0039], [0041], [0042], [0054] and [0069]).

Regarding claims 9 and 53, Sofer further teaches the second system entity is configured to select a route or a destination of at least one multimedia message to be delivered to the user of the user equipment according to the roaming information (see [0004], [0014], [0018], [0029], [0030], [0037], [0039], [0041], [0042], [0054] and [0069]).

Regarding claims 11, 29 and 55, Sofer further teaches the second system entity is configured to determine charging related information according to the roaming information and to add the charging related information to at least one multimedia message to be delivered to the user equipment (see [0020]).

Regarding claims 12 and 30, Sofer further teaches the first system entity is configured to send the message comprising the roaming information about the user equipment to the second system entity in response to a request received from the second system entity (see [0004], [0014], [0018], [0029], [0030], [0037], [0039], [0041], [0042], [0054] and [0069]).

Regarding claims 13 and 31, Sofer further teaches the first system entity is configured to obtain information about a location of the user equipment from another system entity and to determine the roaming information on the user equipment according to the obtained location information before sending the message comprising the roaming information about the user equipment to the second system entity (see [0018], [0019], [0021], [0065] and see [0004], [0014], [0029], [0030], [0037], [0039], [0041], [0042], [0054] and [0069]).

Regarding claims 14, 15, 32, 33, 57 and 58, Sofer further teaches the message comprising the roaming information about the user equipment is an multimedia message interface message (see [0020], [0021], [0067], [0068] and [0070]).

Regarding claims 16 and 34, Sofer further teaches the first system entity comprises a multimedia messaging service center (see [0020], [0021], [0067], [0068] and [0070]).

Regarding claims 17, 35 and 59, Sofer further teaches the second system entity comprises a multimedia messaging service value added service application (see Abstract, [0004], 0014], [0037], [0041], [0042] and [0069]).

Regarding claims 18 and 36, Sofer further teaches the user equipment comprises a mobile station (see fig.2, item 39).

Regarding claims 27, Sofer further teaches selecting, in the second system entity (see fig.1, fig.2 and fig.3), a route or a destination of at least one multimedia message to be delivered to a user of the user equipment according to the roaming information (see [0019], [0067] and [0068]).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 6, 7, 24, 25, 50, 51 and 61-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sofer et al (2006/0030304A1) in view of Fenton et al (US 2003/0193967A1).

Regarding claims 6, 24, 50, 61 and 63, Sofer teaches claims 1, 19, 45, 60, 65 and 66. Sofer does not specifically disclose the second system entity is configured to encrypt or decrypt at least part of the content of the at least one multimedia message to be delivered to the user equipment according to the roaming information.

Fenton teaches the second system entity is configured to encrypt or decrypt at least part of the content of the at least one multimedia message to be delivered to the user equipment according to the roaming information (see [0036]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Fenton into the system of Sofer in order to process the multimedia message using a customized process (see Fenton, Abstract).

Regarding claims 7, 25, 51, 62 and 64, Sofer teaches claims 1, 19, 45, 60, 65 and 66. Sofer does not specifically disclose the second system entity is configured to use digital rights management to perform the encryption or decryption by using digital rights management.

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Fenton teaches the second system entity is configured to use digital rights management to perform the encryption or decryption by using digital rights management (see [0036]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Fenton into the system of Sofer in order to process the multimedia message using a customized process (see Fenton, Abstract).

7. Claims 3, 10, 21, 28, 39, 47 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sofer et al (2006/0030304A1) in view of Elizondo (US 6,917,813).

Regarding claims 3, 21, 39 and 47, Sofer teaches claims 1, 19, 45, 60, 65 and 66. Sofer does not specifically disclose the roaming information comprises an address of a switching centre which the user equipment is using.

Elizondo teaches the roaming information comprises an address of a switching centre which the user equipment is using (see column 2, lines 18-21).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Elizondo into the system of Sofer in order to provide SMS service when different SS7 signaling networks are in use (see [0012]).

Regarding claims 10, 28 and 54, Sofer further teaches the second system entity is configured to determine a location of the user equipment according to the address of

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the switching center that the user equipment is using and provide the user equipment with information relating to the determined location (see [0018], [0019], [0021], [0065]).

Response to Arguments

8. Applicant's arguments with respect to claims 1-3, 5-21, 23-36, 45-47 and 49-66 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nghi H. Ly whose telephone number is (571) 272-7911. The examiner can normally be reached on 9:30am-8:00pm Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Appiah can be reached on (571) 272-7904. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nghi H. Ly

A handwritten signature in black ink, appearing to be 'Nghi H. Ly', written in a cursive style.